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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Attorney Docket No. AUS920010152US1

IN RE APPLICATION OF:

Dutta, et al

Serial No. 09/817,100

Filed: March 26, 2001

For: **THIRD PARTY MERCHANDISE
RETURN SYSTEM**

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Examiner: **Matthew S. Gart**

Art Unit: **3625**

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Brief is submitted in triplicate in support of the Appeal in
the above-identified application.

**CERTIFICATE OF MAILING
37 CFR 1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the date below:

July 22, 2004
Date

[Signature]
Signature

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Serial Number 09/817,100
Attorney Docket No. AUS920010152US1

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:

INVENTOR(S): Dutta, et al
APPL. NUMBER: 09/817,100
FILED: 3/26/2001
TITLE: Third Party
Merchandise Return
System

GROUP ART UNIT: 3625
EXAMINER: Matthew Gart

Docket Number: AUS920010152US1

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to "Honorable Commissioner For Patents, PO Box 1450, Alexandria, Virginia 22313-1450", on the date set forth below:

Signed:

Name: Robert V. Wilder

Date: July 22, 2004

Honorable Commissioner For Patents
PO Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Enclosed herewith is an Appeal Brief, in triplicate, for the above-identified application submitted in response to the Notice of Non-Compliance With 37 CFR 1.192(c) which was mailed 7/14/2004. The concise explanation of the invention has been supplemented with references to the specification and drawings, and the "stand or fall together" language has been included as required by the Primary Examiner Jeffrey A. Smith in the designated Notice.

Respectfully submitted,

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I. With regard to the rejection of claims 1-2, 8-12 and 18-22 under 35 USC 102(e) over Tsunenari, it is submitted that Tsunenari does not teach or even suggest a method for processing a return of an item purchased from a selling merchant by a remote customer, which includes receiving an order which includes customer-related information, for an item being purchased, storing the customer-related information in a storage device, sending the item to the customer from the selling merchant, receiving a return communication from the customer requesting to return the item to the selling merchant, retrieving the customer-related information from the storage device and sending to the customer a shipping communication including portions of the retrieved customer-related information and identifying a receiving entity other than the selling merchant to whom the item is to be returned.	

78		
79	II. With regard to the rejection of claims 3-7, 13-17 and	
80	23-25, under 35 USC 103(a) over Tsunenari in view of Siegel, it	
81	is respectfully submitted that there is no basis, suggestion or	
82	nexus for the hypothetical combination of Tsunenari and Siegel	
83	and that even the hypothetical combination of Tsunenari and	
84	Siegel does not teach, suggest or render obvious, the present	
85	invention as recited in the noted claims.	11
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88	CONCLUSION	13
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93 **REAL PARTY IN INTEREST**

94
95 The present application is assigned to International Business
96 Machines Corporation, the real party in interest.
97

98
99 **RELATED APPEALS AND INTERFERENCES**

100
101 No related appeal is presently pending.
102
103

104 **STATUS OF THE CLAIMS**

105
106 Claims 1-25 are pending and stand finally rejected by the
107 Examiner as noted in the Final Office Action mailed March 22,
108 2003.
109
110

111 **STATUS OF AMENDMENTS**

112
113 Prior to the Final Office Action (mailed 3/22/03), there was only
114 one Office Action mailed 10/31/03 and one Amendment mailed
115 1/31/04. The Second and Final Office Action re-asserted the 35
116 USC 102(e) and 35 USC 103(a) rejections as stated in the 10/31/03
117 Office Action but withdrew the 35 USC 101 and 35 USC 112
118 rejections. The last entered amendment was submitted 1/31/04
119 which amended the claims to the text shown in the Appendix.
120

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SUMMARY OF THE INVENTION

The present application discloses a method and implementing system in which merchants are enabled to designate re-seller return locations to customers for returned items. In an exemplary embodiment, as discussed on pages 4-9 of the specification, when a buyer order has been received, the customer's name and address is recorded or stored (e.g., *inter alia*, page 7, line 26 et seq.). When a merchant is notified that a customer wishes to return an item purchased (e.g., *inter alia*, Fig. 4, #409), the merchant then gets the reseller merchant information (e.g., *inter alia*, page 8, lines 5-9) and sends the customer (e.g., *inter alia*, page 8, lines 1-3) a return label for the returned item containing the address of the re-seller for the merchant (e.g., *inter alia*, Fig. 4, #413). The re-seller then notifies the merchant when the item has been received (e.g., *inter alia*, Fig. 4, #415) and the merchant then credits the account of the customer for the returned item (e.g., *inter alia*, Fig. 4, #417). In a second exemplary embodiment, upon receipt of notice from the customer of the return (e.g., *inter alia*, Fig. 5, #509), the merchant then makes the item available for an auction purchase (e.g., *inter alia*, Fig. 5, #510 and Fig. 3, #306) to a number of re-seller merchants or individuals (e.g., *inter alia*, Fig. 3, #301). When a winning bid is known to the merchant (e.g., *inter alia*, Fig. 5, #511), the return address of the winning bidder is then sent to the customer (e.g., *inter alia*, Fig. 5, #512) for

148 use in returning the purchased item.

149

150 The above methodology is set forth in pending claim 1, which
151 recites:

152

153 "1. A method for processing a return of an item purchased from a selling merchant by a remote
154 customer, said method comprising:

155

156 receiving an order for said item from said customer, said order including customer-related
157 information;

158

159 storing said customer-related information in a storage device;

160

161 sending said item to said customer by said selling merchant;

162

163 receiving a return communication from said customer requesting a return of said item to said
164 selling merchant;

165

166 retrieving said customer-related information from said storage device; and

167

168 sending a shipping communication including portions of said customer-related information to said
169 customer, said shipping communication identifying a receiving entity other than said selling
170 merchant to whom said item is to be returned."

171

172

173 **ISSUES**

174

175 1. Is the Examiner's rejection of claims 1-2, 8-12 and 18-22
176 under 35 USC 102(e) as being anticipated by the Tsunenari Patent

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177 Application Publication US 2002/0013744 (hereinafter referred to
178 as "Tsunenari") well founded?

179
180 2. Is the Examiner's rejection of claims 3-7, 13-17 and 23-25
181 under 35 USC 103(a) as being unpatentable over Tsunenari in view
182 of the Siegel Patent Application Publication US 2001/0032147
183 (hereinafter referred to as "Siegel") well founded and is the
184 hypothetical combination of Tsunenari and Siegel suggested by
185 either reference?

186

187

188 **GROUPING OF THE CLAIMS**

189

190 For purposes of this Appeal, claims 1-10 stand or fall together
191 as a single method group, claims 11-20 stand or fall together as
192 a single medium group and claims 21-25 stand or fall together as
193 a single system group. Independent claim 1 and claims 2-10, which
194 ultimately depend from claim 1, comprise a group of various
195 combinations of the claimed methodology; independent claim 11 and
196 claims 12-20, which ultimately depend from claim 11, comprise a
197 medium embodiment generally corresponding to claims 1-10; and
198 claim 21, and claims 22-25 which ultimately depend from claim 21,
199 define a processing system embodying the disclosed methodology.

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ARGUMENT

I. With regard to the rejection of claims 1-2, 8-12 and 18-22 under 35 USC 102(e) over Tsunenari, it is submitted that Tsunenari does not teach or even suggest a method for processing a return of an item purchased from a selling merchant by a remote customer, which includes receiving an order, including customer-related information, for an item being purchased, storing the customer-related information in a storage device, sending the item to the customer from the selling merchant, receiving a return communication from the customer requesting to return the item to the selling merchant, retrieving the customer-related information from the storage device and sending to the customer a shipping communication including portions of the retrieved customer-related information and identifying a receiving entity other than the selling merchant to whom the item is to be returned.

All of the above limitations and relationships are included in the broadest claims 1, 11 and 21 and clearly disclosed and supported in the specification and drawings. Tsunenari falls short of disclosing several of the above-recited limitations. Tsunenari discloses a server system which effects the return of a consumer product by a third party. Although paragraphs 0013-0018 of Tsunenari are cited by the Examiner as disclosing "receiving an order", and "sending said item", it is noted that there is no mention in any of the cited paragraphs regarding the receiving of an order or the sending of an item as those steps are specifically set forth in the claims. Rather, Tsunenari discloses a return system that does not necessarily involve a selling

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235 merchant at the front end but rather begins when a client sends a
236 return notice to an independent agency. That is why the return
237 agency must send one or more form pages to the client to gather
238 client-related information. Tsunenari teaches, **as a necessary**
239 **element**, the use of a network server **presenting to a client one**
240 **or more form pages adapted to elicit consumer information**
241 including an identification of the consumer product to be
242 returned and an identification of the present location of the
243 consumer product. The form pages are presented to the consumer
244 after the server receives a communication that the consumer
245 wishes to return a product. Thus, a customer must first send
246 notice to an agency server that the customer wishes to return a
247 product and this request is then followed by the sending of "one
248 or more form pages" back to the customer to completed by the
249 customer who then must again send the completed forms back to the
250 returning agency server (and make further corrections as may be
251 required by further communications) before the return process can
252 continue. The present invention, by contrast, needs only to
253 retrieve customer-related information that is already in storage
254 at the server thereby obviating the need for the customer to
255 complete "one or more form pages" and process at least two more
256 communication transactions. The present invention thereby
257 significantly accelerates and facilitates the return process by
258 storing the customer-related information at a server site when a
259 sale is made and having that information available at the server
260 site for immediate retrieval if a return request is made by a
261 customer.

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265 More specifically, the broadest claims 1, 11 and 21 recite, *inter*
266 *alia*:
267
268 "receiving an order for said item from said customer, said order
269 including customer-related information" - Tsunenari does not
270 disclose the specified receiving of an order;
271
272 "storing said customer-related information in a storage device" -
273 Tsunenari does not disclose the specified storing of customer-
274 related information following the receipt of an order;
275
276 "sending said item to said customer by said selling merchant" -
277 Tsunenari does not disclose the specified sending of a purchased
278 item to a customer from the selling merchant;
279
280 "receiving a return communication from said customer requesting a
281 return of said item to said selling merchant" - Tsunenari does
282 not disclose the specified receiving of return communication by
283 the selling merchant (Tsunenari discloses only a receipt of
284 customer information by a third party);
285
286 "retrieving said customer-related information from said storage
287 device" - Tsunenari does not disclose the specified retrieving of
288 customer information from the merchant's storage device - in fact
289 Tsunenari does not disclose the retrieval of customer information
290 from any pre-existing database; and
291
292 "sending a shipping communication including portions of said
293 customer-related information to said customer, said shipping
294 communication identifying a receiving entity other than said

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295 selling merchant to whom said item is to be returned" - Tsunenari
296 does not disclose the specified sending of a shipping
297 communication including portions of the customer-related
298 information as defined in the claim as being customer-related
299 information that was stored at the time the order was placed and
300 retrieved by the merchant when a return was requested.

301
302 Lacking at least the above-noted seven distinct claimed elements,
303 and the recited specific relationships among those elements, it
304 is submitted that Tsunenari can not be said to anticipate the
305 independent claims 1, 11 and 21 of the present application.
306 Further, since dependent claims 2, 8-10, 12, 18-20 and 22,
307 ultimately depend from one of independent claims 1, 11 or 21, and
308 include all of the limitations of the respective independent
309 claim in addition to even further limitations as recited in the
310 individual dependent claims, it is clear that claims 2, 8-10, 12,
311 18-20 and 22-25 are also not anticipated by Tsunenari. Thus, it
312 is submitted that claims 1-2, 8-12 and 18-22 are allowable under
313 35 USC 102(e) over Tsunenari.

314
315 II. With regard to the rejection of claims 3-7, 13-17 and
316 23-25, under 35 USC 103(a) over Tsunenari in view of Siegel, it
317 is noted that Siegel, like Tsunenari, discloses a third party
318 return system which also requires the gathering of initial
319 transaction information by the third party from a purchaser of a
320 remotely purchased product, a step that is rendered redundant and
321 unnecessary by the present invention since, with the present
322 invention, the customer-related information is already stored by
323 the merchant at the time of the sale and later retrieved from the
324 merchant's database when a return is requested. Siegel is cited

325 to disclose disjointed bits and pieces of the specified dependent
326 claims without regard for the total combination of claimed
327 elements and relationships as set forth in the dependent claims
328 of the present application, in combination with the limitations
329 of the intervening dependent claims and the referenced
330 independent claim. Even a direct substitution of Siegel into the
331 Tsunenari system (for which there is no suggestion in either
332 reference) would fall short of disclosing or teaching at least
333 the same specifically claimed elements and relationships as
334 discussed above, and so, even if the proposed combination of
335 Tsunenari and Siegel was suggested by one of the references
336 (which it is not), the proposed combination would still not
337 render claims 3-7, 13-17 and 23-25 obvious since at least the
338 seven claimed elements and relationships among those elements as
339 hereinbefore stated, are still missing even from a combination of
340 Tsunenari and Siegel.

341
342 Further, it is submitted that there is no suggestion or reason in
343 either Tsunenari or Siegel for the combination of the two
344 references for any purpose. Thus lacking any reason, nexus or
345 suggestion in either of the references for the proposed
346 hypothetical combination, it is respectfully submitted that the
347 combination of Tsunenari and Siegel is not a proper combination
348 of references, and is not suggested by either reference. Rather,
349 it is submitted that the only possible suggestion for the
350 hypothetical combination of Tsunenari and Siegel can be found in
351 applicant's disclosure, which cannot be used to reject
352 applicant's own claims. Thus it is submitted that there is no
353 basis in either Tsunenari or Siegel for the proposed combination
354 under 35 USC 103(a).

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355
356 Further, even a hypothetical combination of Tsunenari and Siegel
357 does not render the present invention (as set forth in claims 3-
358 7, 13-17 and 23-25, together with the further limitations set
359 forth in the respective intervening and independent claims)
360 obvious under 35 USC 103(a) since such a combination of
361 references still lacks the disclosure of the specifically recited
362 combination of elements and relationships as noted above.

363
364 It is therefore submitted that claims 3-7, 13-17 and 23-25 are
365 allowable under 35 USC 103(a) over Tsunenari in view of Siegel.
366

367
368 **CONCLUSION**
369

370 For the reasons stated above, applicant urges the Board to
371 consider that neither Tsunenari nor Siegel, alone or in
372 combination, discloses or even suggests a method or system for
373 processing a return of an item purchased from a selling merchant
374 by a remote customer, which includes the entire combination of
375 receiving an order for an item to be purchased with the order
376 including customer-related information, storing the customer-
377 related information in a storage device, sending the item to the
378 customer from the selling merchant, receiving a return
379 communication from the customer requesting to return the item to
380 the selling merchant, retrieving the customer-related information
381 from the storage device and sending to the customer a shipping
382 communication including portions of the retrieved customer-
383 related information and identifying a receiving entity other than
384 the selling merchant to whom the item is to be returned, as those

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385 functions and relationships are set forth in the pending claims
386 1-25.

387
388 Consequently, applicant urges that the rejections of claims 1-2,
389 8-12 and 18-22 under 35 USC 102(e) as being anticipated by the
390 Tsunenari, and claims 3-7, 13-17 and 23-25 under 35 USC 103(a) as
391 being unpatentable over Tsunenari in view of the Siegel, are not
392 well-founded and should be reversed.

393
394 Please charge IBM Corporation Deposit Account No. 09-0447 in the
395 amount of \$330.00 for submission of a Brief in Support of Appeal.
396 No additional fee or extension of time is believed to be
397 required; however, in the event an additional fee or extension of
398 time is required, please charge the fee, as well as any other fee
399 necessary to further the prosecution of this application, to the
400 above-identified deposit account.

401
402 Respectfully submitted,

403

404

405

406



407 Robert V. Wilder (Tel:512-246-8555)

408 Registration No. 26,352

409 Attorney at Law

410 4235 Kingsburg Drive

411 Round Rock, Texas 78681

412

413 ATTORNEY FOR APPLICANT

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APPENDIX

1. A method for processing a return of an item purchased from a selling merchant by a remote customer, said method comprising:

receiving an order for said item from said customer, said order including customer-related information;

storing said customer-related information in a storage device;

sending said item to said customer by said selling merchant;

receiving a return communication from said customer requesting a return of said item to said selling merchant;

retrieving said customer-related information from said storage device; and

sending a shipping communication including portions of said customer-related information to said customer, said shipping communication identifying a receiving entity other than said selling merchant to whom said item is to be returned.

2. The method as set forth in claim 1 and further including:

receiving a return receipt notice from said receiving entity when said item has been received by said receiving entity.

441
442
443 3. The method as set forth in claim 2 wherein said method further
444 includes:
445
446 charging a designated customer account after receiving said
447 order.
448
449 4. The method as set forth in claim 3 and further including
450 crediting said customer account after receiving said return
451 receipt notice from said receiving entity.
452
453 5. The method as set forth in claim 4 and further including
454 sending notice of said crediting to said customer.
455
456 6. The method as set forth in claim 1 and further including:
457
458 effecting an auction of said item following said receiving of
459 said return communication from said customer, said receiving
460 entity being a winner of said auction.
461
462 7. The method as set forth in claim 1 and further including
463 maintaining a database for storing information concerning said
464 customer, said item and said receiving entity, said database
465 being updated upon receipt of an order, a return request or a
466 return receipt notice.
467
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469 8. The method as set forth in claim 1 wherein said receiving of
470 said return request and said sending of said shipping
471 communication are accomplished by email communication.
472

473 9. The method as set forth in claim 8 wherein said return receipt
474 notice is accomplished by email.
475

476 10. The method as set forth in claim 4 wherein said notice of
477 said crediting is accomplished by email.
478

479 11. A storage medium including machine readable coded indicia,
480 said storage medium being selectively coupled through a reading
481 device to processing circuitry within a computing system, said
482 reading device being selectively operable to read said machine
483 readable coded indicia and provide program signals representative
484 thereof, said program signals being effective to process a return
485 of an item purchased by a customer, said program signals being
486 selectively operable to accomplish the steps of:

487
488 receiving an order for said item from said customer, said order
489 including customer-related information;
490

491 storing said customer-related information in a storage device;
492

493 effecting a sending of said item to said customer by said selling
494 merchant;
495

496 receiving a return communication from said customer requesting a

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497 return of said item to said selling merchant;
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499 retrieving said customer-related information from said storage
500 device; and
501
502 sending a shipping communication including portions of said
503 customer-related information to said customer, said shipping
504 communication identifying a receiving entity other than said
505 selling merchant to whom said item is to be returned.
506
507 12. The medium as set forth in claim 11 wherein said program
508 signals are further operable for:
509
510 effecting a receipt a return receipt notice from said receiving
511 entity when said item has been received by said receiving entity.
512
513 13. The medium as set forth in claim 12 wherein said program
514 signals are further operable for:
515
516 effecting a charging a designated customer account after
517 receiving said order.
518
519 14. The medium as set forth in claim 13 wherein said program
520 signals are further operable for effecting a crediting of said
521 customer account after receiving said return receipt notice from
522 said receiving entity.
523
524

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525 15. The medium as set forth in claim 14 wherein said program
526 signals are further operable for effecting said sending of said
527 notice of said crediting to said customer.

528
529 16. The medium as set forth in claim 11 wherein said program
530 signals are further operable for effecting an initiation of an
531 auction of said item following said receiving of said return
532 communication from said customer, said receiving entity being a
533 winner of said auction.

534
535 17. The medium as set forth in claim 11 and further including
536 maintaining a database for storing information concerning said
537 customer, said item and said receiving entity, said program
538 signals being further operable for updating said database upon
539 receipt of an order, a return request or a return receipt notice.

540
541 18. The medium as set forth in claim 11 wherein said receiving of
542 said return request and said sending of said shipping
543 communication are accomplished by email communication.

544
545 19. The medium as set forth in claim 18 wherein said return
546 receipt notice is accomplished by email.

547
548 20. The medium as set forth in claim 14 wherein said notice of
549 said crediting is accomplished by email.

21. A processing system including a system bus, a processor, a memory system, and a network interface, all coupled to said system bus, said processing system being operable in response to an item return program being executed from said memory system for effecting a return of an item purchased from a selling merchant by a customer at a remote location through said network interface, said processing system being selectively operable to receive an order for said item from said customer over said network interface, said order including customer-related information, storing said customer-related information in said memory system, and effecting a sending of said item to said customer by said selling merchant, said processing system being further operable for receiving a return communication from said customer requesting a return of said item to said selling merchant, retrieving said customer-related information from said memory system, and sending a shipping communication including portions of said customer-related information to said customer, said shipping communication identifying a receiving entity other than said selling merchant to whom said item is to be returned.

22. The system as set forth in claim 21 and further including:
receiving a return receipt notice from said receiving entity through said network interface when said item has been received by said receiving entity.

581 23. The system as set forth in claim 22 wherein said method
582 further includes:

583
584 charging a designated customer account in said memory system
585 after receiving said order.

586
587 24. The system as set forth in claim 23 and further including
588 crediting said customer account in said memory system after
589 receiving said return receipt notice from said receiving entity.
590

591 25. The system as set forth in claim 24 wherein said system is
592 further operable to effect a sending of a notice of said
593 crediting to said customer through said network interface.

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I. With regard to the rejection of claims 1-2, 8-12 and 18-22 under 35 USC 102(e) over Tsunenari, it is submitted that Tsunenari does not teach or even suggest a method for processing a return of an item purchased from a selling merchant by a remote customer, which includes receiving an order which includes customer-related information, for an item being purchased, storing the customer-related information in a storage device, sending the item to the customer from the selling merchant, receiving a return communication from the customer requesting to return the item to the selling merchant, retrieving the customer-related information from the storage device and sending to the customer a shipping communication including portions of the retrieved customer-related information and identifying a receiving entity other than the selling merchant to whom the item is to be returned. 8

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78		
79	II. With regard to the rejection of claims 3-7, 13-17 and	
80	23-25, under 35 USC 103(a) over Tsunenari in view of Siegel, it	
81	is respectfully submitted that there is no basis, suggestion or	
82	nexus for the hypothetical combination of Tsunenari and Siegel	
83	and that even the hypothetical combination of Tsunenari and	
84	Siegel does not teach, suggest or render obvious, the present	
85	invention as recited in the noted claims.	11
86		
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88	CONCLUSION	13
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90	APPENDIX (Pending Claims)	15-21
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REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, the real party in interest.

RELATED APPEALS AND INTERFERENCES

No related appeal is presently pending.

STATUS OF THE CLAIMS

Claims 1-25 are pending and stand finally rejected by the Examiner as noted in the Final Office Action mailed March 22, 2003.

STATUS OF AMENDMENTS

Prior to the Final Office Action (mailed 3/22/03), there was only one Office Action mailed 10/31/03 and one Amendment mailed 1/31/04. The Second and Final Office Action re-asserted the 35 USC 102(e) and 35 USC 103(a) rejections as stated in the 10/31/03 Office Action but withdrew the 35 USC 101 and 35 USC 112 rejections. The last entered amendment was submitted 1/31/04 which amended the claims to the text shown in the Appendix.

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SUMMARY OF THE INVENTION

The present application discloses a method and implementing system in which merchants are enabled to designate re-seller return locations to customers for returned items. In an exemplary embodiment, as discussed on pages 4-9 of the specification, when a buyer order has been received, the customer's name and address is recorded or stored (e.g., *inter alia*, page 7, line 26 et seq.). When a merchant is notified that a customer wishes to return an item purchased (e.g., *inter alia*, Fig. 4, #409), the merchant then gets the reseller merchant information (e.g., *inter alia*, page 8, lines 5-9) and sends the customer (e.g., *inter alia*, page 8, lines 1-3) a return label for the returned item containing the address of the re-seller for the merchant (e.g., *inter alia*, Fig. 4, #413). The re-seller then notifies the merchant when the item has been received (e.g., *inter alia*, Fig. 4, #415) and the merchant then credits the account of the customer for the returned item (e.g., *inter alia*, Fig. 4, #417). In a second exemplary embodiment, upon receipt of notice from the customer of the return (e.g., *inter alia*, Fig. 5, #509), the merchant then makes the item available for an auction purchase (e.g., *inter alia*, Fig. 5, #510 and Fig. 3, #306) to a number of re-seller merchants or individuals (e.g., *inter alia*, Fig. 3, #301). When a winning bid is known to the merchant (e.g., *inter alia*, Fig. 5, #511), the return address of the winning bidder is then sent to the customer (e.g., *inter alia*, Fig. 5, #512) for

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148 use in returning the purchased item.

149

150 The above methodology is set forth in pending claim 1, which
151 recites:

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153 "1. A method for processing a return of an item purchased from a selling merchant by a remote
154 customer, said method comprising:

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156 receiving an order for said item from said customer, said order including customer-related
157 information;

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159 storing said customer-related information in a storage device;

160

161 sending said item to said customer by said selling merchant;

162

163 receiving a return communication from said customer requesting a return of said item to said
164 selling merchant;

165

166 retrieving said customer-related information from said storage device; and

167

168 sending a shipping communication including portions of said customer-related information to said
169 customer, said shipping communication identifying a receiving entity other than said selling
170 merchant to whom said item is to be returned."

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172

173 ISSUES

174

175 1. Is the Examiner's rejection of claims 1-2, 8-12 and 18-22
176 under 35 USC 102(e) as being anticipated by the Tsunenari Patent

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177 Application Publication US 2002/0013744 (hereinafter referred to
178 as "Tsunenari") well founded?
179

180 2. Is the Examiner's rejection of claims 3-7, 13-17 and 23-25
181 under 35 USC 103(a) as being unpatentable over Tsunenari in view
182 of the Siegel Patent Application Publication US 2001/0032147
183 (hereinafter referred to as "Siegel") well founded and is the
184 hypothetical combination of Tsunenari and Siegel suggested by
185 either reference?
186
187

188 **GROUPING OF THE CLAIMS**
189

190 For purposes of this Appeal, claims 1-10 stand or fall together
191 as a single method group, claims 11-20 stand or fall together as
192 a single medium group and claims 21-25 stand or fall together as
193 a single system group. Independent claim 1 and claims 2-10, which
194 ultimately depend from claim 1, comprise a group of various
195 combinations of the claimed methodology; independent claim 11 and
196 claims 12-20, which ultimately depend from claim 11, comprise a
197 medium embodiment generally corresponding to claims 1-10; and
198 claim 21, and claims 22-25 which ultimately depend from claim 21,
199 define a processing system embodying the disclosed methodology.
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ARGUMENT

I. With regard to the rejection of claims 1-2, 8-12 and 18-22 under 35 USC 102(e) over Tsunenari, it is submitted that Tsunenari does not teach or even suggest a method for processing a return of an item purchased from a selling merchant by a remote customer, which includes receiving an order, including customer-related information, for an item being purchased, storing the customer-related information in a storage device, sending the item to the customer from the selling merchant, receiving a return communication from the customer requesting to return the item to the selling merchant, retrieving the customer-related information from the storage device and sending to the customer a shipping communication including portions of the retrieved customer-related information and identifying a receiving entity other than the selling merchant to whom the item is to be returned.

All of the above limitations and relationships are included in the broadest claims 1, 11 and 21 and clearly disclosed and supported in the specification and drawings. Tsunenari falls short of disclosing several of the above-recited limitations. Tsunenari discloses a server system which effects the return of a consumer product by a third party. Although paragraphs 0013-0018 of Tsunenari are cited by the Examiner as disclosing "receiving an order", and "sending said item", it is noted that there is no mention in any of the cited paragraphs regarding the receiving of an order or the sending of an item **as those steps are specifically set forth in the claims**. Rather, Tsunenari discloses a return system that does not necessarily involve a selling

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235 merchant at the front end but rather begins when a client sends a
236 return notice to an independent agency. That is why the return
237 agency must send one or more form pages to the client to gather
238 client-related information. Tsunenari teaches, **as a necessary**
239 **element,** the use of a network server **presenting to a client one**
240 **or more form pages adapted to elicit consumer information**
241 including an identification of the consumer product to be
242 returned and an identification of the present location of the
243 consumer product. The form pages are presented to the consumer
244 after the server receives a communication that the consumer
245 wishes to return a product. Thus, a customer must first send
246 notice to an agency server that the customer wishes to return a
247 product and this request is then followed by the sending of "one
248 or more form pages" back to the customer to completed by the
249 customer who then must again send the completed forms back to the
250 returning agency server (and make further corrections as may be
251 required by further communications) before the return process can
252 continue. The present invention, by contrast, needs only to
253 retrieve customer-related information that is already in storage
254 at the server thereby obviating the need for the customer to
255 complete "one or more form pages" and process at least two more
256 communication transactions. The present invention thereby
257 significantly accelerates and facilitates the return process by
258 storing the customer-related information at a server site when a
259 sale is made and having that information available at the server
260 site for immediate retrieval if a return request is made by a
261 customer.

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265 More specifically, the broadest claims 1, 11 and 21 recite, *inter*
266 *alia*:
267
268 "receiving an order for said item from said customer, said order
269 including customer-related information" - Tsunenari does not
270 disclose the specified receiving of an order;
271
272 "storing said customer-related information in a storage device" -
273 Tsunenari does not disclose the specified storing of customer-
274 related information following the receipt of an order;
275
276 "sending said item to said customer by said selling merchant" -
277 Tsunenari does not disclose the specified sending of a purchased
278 item to a customer from the selling merchant;
279
280 "receiving a return communication from said customer requesting a
281 return of said item to said selling merchant" - Tsunenari does
282 not disclose the specified receiving of return communication by
283 the selling merchant (Tsunenari discloses only a receipt of
284 customer information by a third party);
285
286 "retrieving said customer-related information from said storage
287 device" - Tsunenari does not disclose the specified retrieving of
288 customer information from the merchant's storage device - in fact
289 Tsunenari does not disclose the retrieval of customer information
290 from any pre-existing database; and
291
292 "sending a shipping communication including portions of said
293 customer-related information to said customer, said shipping
294 communication identifying a receiving entity other than said

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295 selling merchant to whom said item is to be returned" - Tsunenari
296 does not disclose the specified sending of a shipping
297 communication including portions of the customer-related
298 information as defined in the claim as being customer-related
299 information that was stored at the time the order was placed and
300 retrieved by the merchant when a return was requested.

301
302 Lacking at least the above-noted seven distinct claimed elements,
303 and the recited specific relationships among those elements, it
304 is submitted that Tsunenari can not be said to anticipate the
305 independent claims 1, 11 and 21 of the present application.
306 Further, since dependent claims 2, 8-10, 12, 18-20 and 22,
307 ultimately depend from one of independent claims 1, 11 or 21, and
308 include all of the limitations of the respective independent
309 claim in addition to even further limitations as recited in the
310 individual dependent claims, it is clear that claims 2, 8-10, 12,
311 18-20 and 22-25 are also not anticipated by Tsunenari. Thus, it
312 is submitted that claims 1-2, 8-12 and 18-22 are allowable under
313 35 USC 102(e) over Tsunenari.

314
315 II. With regard to the rejection of claims 3-7, 13-17 and
316 23-25, under 35 USC 103(a) over Tsunenari in view of Siegel, it
317 is noted that Siegel, like Tsunenari, discloses a third party
318 return system which also requires the gathering of initial
319 transaction information by the third party from a purchaser of a
320 remotely purchased product, a step that is rendered redundant and
321 unnecessary by the present invention since, with the present
322 invention, the customer-related information is already stored by
323 the merchant at the time of the sale and later retrieved from the
324 merchant's database when a return is requested. Siegel is cited

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325 to disclose disjointed bits and pieces of the specified dependent
326 claims without regard for the total combination of claimed
327 elements and relationships as set forth in the dependent claims
328 of the present application, in combination with the limitations
329 of the intervening dependent claims and the referenced
330 independent claim. Even a direct substitution of Siegel into the
331 Tsunenari system (for which there is no suggestion in either
332 reference) would fall short of disclosing or teaching at least
333 the same specifically claimed elements and relationships as
334 discussed above, and so, even if the proposed combination of
335 Tsunenari and Siegel was suggested by one of the references
336 (which it is not), the proposed combination would still not
337 render claims 3-7, 13-17 and 23-25 obvious since at least the
338 seven claimed elements and relationships among those elements as
339 hereinbefore stated, are still missing even from a combination of
340 Tsunenari and Siegel.

341
342 Further, it is submitted that there is no suggestion or reason in
343 either Tsunenari or Siegel for the combination of the two
344 references for any purpose. Thus lacking any reason, nexus or
345 suggestion in either of the references for the proposed
346 hypothetical combination, it is respectfully submitted that the
347 combination of Tsunenari and Siegel is not a proper combination
348 of references, and is not suggested by either reference. Rather,
349 it is submitted that the only possible suggestion for the
350 hypothetical combination of Tsunenari and Siegel can be found in
351 applicant's disclosure, which cannot be used to reject
352 applicant's own claims. Thus it is submitted that there is no
353 basis in either Tsunenari or Siegel for the proposed combination
354 under 35 USC 103(a).

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355
356 Further, even a hypothetical combination of Tsunenari and Siegel
357 does not render the present invention (as set forth in claims 3-
358 7, 13-17 and 23-25, together with the further limitations set
359 forth in the respective intervening and independent claims)
360 obvious under 35 USC 103(a) since such a combination of
361 references still lacks the disclosure of the specifically recited
362 combination of elements and relationships as noted above.

363
364 It is therefore submitted that claims 3-7, 13-17 and 23-25 are
365 allowable under 35 USC 103(a) over Tsunenari in view of Siegel.
366

367
368 CONCLUSION
369

370 For the reasons stated above, applicant urges the Board to
371 consider that neither Tsunenari nor Siegel, alone or in
372 combination, discloses or even suggests a method or system for
373 processing a return of an item purchased from a selling merchant
374 by a remote customer, which includes the entire combination of
375 receiving an order for an item to be purchased with the order
376 including customer-related information, storing the customer-
377 related information in a storage device, sending the item to the
378 customer from the selling merchant, receiving a return
379 communication from the customer requesting to return the item to
380 the selling merchant, retrieving the customer-related information
381 from the storage device and sending to the customer a shipping
382 communication including portions of the retrieved customer-
383 related information and identifying a receiving entity other than
384 the selling merchant to whom the item is to be returned, as those

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APPENDIX

1. A method for processing a return of an item purchased from a selling merchant by a remote customer, said method comprising:

receiving an order for said item from said customer, said order including customer-related information;

storing said customer-related information in a storage device;

sending said item to said customer by said selling merchant;

receiving a return communication from said customer requesting a return of said item to said selling merchant;

retrieving said customer-related information from said storage device; and

sending a shipping communication including portions of said customer-related information to said customer, said shipping communication identifying a receiving entity other than said selling merchant to whom said item is to be returned.

2. The method as set forth in claim 1 and further including:

receiving a return receipt notice from said receiving entity when said item has been received by said receiving entity.

441
442
443 3. The method as set forth in claim 2 wherein said method further
444 includes:
445
446 charging a designated customer account after receiving said
447 order.
448
449 4. The method as set forth in claim 3 and further including
450 crediting said customer account after receiving said return
451 receipt notice from said receiving entity.
452
453 5. The method as set forth in claim 4 and further including
454 sending notice of said crediting to said customer.
455
456 6. The method as set forth in claim 1 and further including:
457
458 effecting an auction of said item following said receiving of
459 said return communication from said customer, said receiving
460 entity being a winner of said auction.
461
462 7. The method as set forth in claim 1 and further including
463 maintaining a database for storing information concerning said
464 customer, said item and said receiving entity, said database
465 being updated upon receipt of an order, a return request or a
466 return receipt notice.
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469 8. The method as set forth in claim 1 wherein said receiving of
470 said return request and said sending of said shipping
471 communication are accomplished by email communication.
472
473 9. The method as set forth in claim 8 wherein said return receipt
474 notice is accomplished by email.
475
476 10. The method as set forth in claim 4 wherein said notice of
477 said crediting is accomplished by email.
478
479 11. A storage medium including machine readable coded indicia,
480 said storage medium being selectively coupled through a reading
481 device to processing circuitry within a computing system, said
482 reading device being selectively operable to read said machine
483 readable coded indicia and provide program signals representative
484 thereof, said program signals being effective to process a return
485 of an item purchased by a customer, said program signals being
486 selectively operable to accomplish the steps of:
487
488 receiving an order for said item from said customer, said order
489 including customer-related information;
490
491 storing said customer-related information in a storage device;
492
493 effecting a sending of said item to said customer by said selling
494 merchant;
495
496 receiving a return communication from said customer requesting a

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497 return of said item to said selling merchant;
498
499 retrieving said customer-related information from said storage
500 device; and
501
502 sending a shipping communication including portions of said
503 customer-related information to said customer, said shipping
504 communication identifying a receiving entity other than said
505 selling merchant to whom said item is to be returned.
506
507 12. The medium as set forth in claim 11 wherein said program
508 signals are further operable for:
509
510 effecting a receipt a return receipt notice from said receiving
511 entity when said item has been received by said receiving entity.
512
513 13. The medium as set forth in claim 12 wherein said program
514 signals are further operable for:
515
516 effecting a charging a designated customer account after
517 receiving said order.
518
519 14. The medium as set forth in claim 13 wherein said program
520 signals are further operable for effecting a crediting of said
521 customer account after receiving said return receipt notice from
522 said receiving entity.
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15. The medium as set forth in claim 14 wherein said program signals are further operable for effecting said sending of said notice of said crediting to said customer.

16. The medium as set forth in claim 11 wherein said program signals are further operable for effecting an initiation of an auction of said item following said receiving of said return communication from said customer, said receiving entity being a winner of said auction.

17. The medium as set forth in claim 11 and further including maintaining a database for storing information concerning said customer, said item and said receiving entity, said program signals being further operable for updating said database upon receipt of an order, a return request or a return receipt notice.

18. The medium as set forth in claim 11 wherein said receiving of said return request and said sending of said shipping communication are accomplished by email communication.

19. The medium as set forth in claim 18 wherein said return receipt notice is accomplished by email.

20. The medium as set forth in claim 14 wherein said notice of said crediting is accomplished by email.

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21. A processing system including a system bus, a processor, a memory system, and a network interface, all coupled to said system bus, said processing system being operable in response to an item return program being executed from said memory system for effecting a return of an item purchased from a selling merchant by a customer at a remote location through said network interface, said processing system being selectively operable to receive an order for said item from said customer over said network interface, said order including customer-related information, storing said customer-related information in said memory system, and effecting a sending of said item to said customer by said selling merchant, said processing system being further operable for receiving a return communication from said customer requesting a return of said item to said selling merchant, retrieving said customer-related information from said memory system, and sending a shipping communication including portions of said customer-related information to said customer, said shipping communication identifying a receiving entity other than said selling merchant to whom said item is to be returned.

22. The system as set forth in claim 21 and further including:
receiving a return receipt notice from said receiving entity through said network interface when said item has been received by said receiving entity.

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581 23. The system as set forth in claim 22 wherein said method
582 further includes:
583
584 charging a designated customer account in said memory system
585 after receiving said order.
586
587 24. The system as set forth in claim 23 and further including
588 crediting said customer account in said memory system after
589 receiving said return receipt notice from said receiving entity.
590
591 25. The system as set forth in claim 24 wherein said system is
592 further operable to effect a sending of a notice of said
593 crediting to said customer through said network interface.

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